

Office Action Summary	Application No. 09/810,650	Applicant(s) URANO ET AL.	
	Examiner Laura L. Stockton, Ph.D.	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7 is/are allowed.
- 6) ☒ Claim(s) 8-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 7-10 are pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C.

112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-10 are rejected under 35 U.S.C. 112, first paragraph, the description requirements therein.

The introduction of claim changes which involve narrowing the claims by introducing elements or limitations which are not supported by the as-filed disclosure is a violation of the written disclosure requirement of 35 U.S.C. 112, first paragraph. M.P.E.P. 2163.04 and 2163.05. As stated in *Fujikawa v. Wattansasin*, 93 F.3d 1559, 39 USPQ2D 1985 (Fed. Cir. 1996), “a laundry list disclosure of every possible moiety does not constitute a written description of every species in a genus because it

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would not reasonably lead those skilled in the art to any particular species.

Claim 10, newly presented, is rejected under 35 U.S.C. 112, first paragraph, the description requirements therein. Specifically, the formula depicted in the claim is not described in the specification as originally filed. Note particularly the "C=N" portion of the formula.

Claims 8 and 9 are rejected under 35 U.S.C. 112, first paragraph, the description therein, for reasons essentially given in the last Office Action, pages 2 and 3. More specifically, in claim 8, the expression "wherein R¹ is a cyclic alkyl group in which the alkyl group is hexyl; and R² is a cyclic alkyl group in which the alkyl group is hexyl" lacks description in the original specification and the original claims.

However, there is description in the instant specification of U.S. Pat. 5,216,135 (column 2, line 52) for bis(cyclohexylsulfonyl)diazomethane.

Specifically, in claim 9, the expression "where R¹ is a branched alkyl group in which the alkyl group is butyl; and R² is a branched alkyl group in which the alkyl group is butyl" lacks description in the original

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specification and the original claims. However, there is description in the instant specification of U.S. Pat. 5,216,135 (column 2, lines 55 and 56) for bis(tert-butylsulfonyl)diazomethane and bis(sec-butylsulfonyl)diazomethane.

Response to Arguments

Applicants' arguments, filed December 30, 2002, to the rejections under 35 U.S.C. 112, first paragraph, of claims 8 and 9 have been fully considered. Applicants argue that: (1) an explanation has not been given for the claims lacking support in the U.S. and the Japanese applications; (2) precise words are being required to satisfy the written description requirement; (3) claims 8 and 9 are different from claims 2 and 3 (both now cancelled) and therefore, the decision by the CAFC cannot be relied upon to reject claims 8 and 9; and (4) the comments in the Tockman Declaration regarding support in the Japanese priority document have not been addressed.

All of Applicants' arguments have been amply considered but have not been found persuasive.

(1) The previous Office Action clearly indicated which parts of the claimed subject matter lack written description. In response, Applicants have indicated that claims 8 and 9 find support in the reissue specification at column 2, lines 32-48 (Paper No. 41, page 7). However, this description is not adequate for instant claims 8 and 9. The genus found in column 2, lines 16-48 does not describe the subject matter of claims 8 and 9. There is no guidance in the disclosure in column 2, lines 16-48 of the specification to arrive at the subject matter as claimed in instant claims 8 and 9. Therefore, the subject matter of claims 8 and 9 are not adequately described in the instant application.

(2) A precise exact language of the claims in the specification is not required. What has been indicated is that the claims lack description in the specification, and that Applicants, upon alleged description (e.g., column 2, lines 32-48), does not provide description for the claimed subject matter. All Applicants have done is to quote a section of the

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specification and then conclude that it supports the claimed subject matter.

(3) Applicants state that claims 8 and 9 are quite different from claims 2 and 3 (both now cancelled) and therefore, the Judgment of the CAFC cannot be relied upon. Reexam 90/004812 has been merged with the instant Reissue application. The Examiner cannot ignore a CAFC Judgment (Reexam 90/004812) or a Decision by the Board of Appeals and Interferences (Reexam 90/004812) that relate to any claimed subject matter. For the subject matter appealed to the Board, claims 1-6, the position of the Examiner was affirmed. It is noted that the subject matter of claims 2 and 3 was not appealed to the CAFC, at Applicants' choosing, and that for the subject matter appealed, claims 1 and 4-6, the position of the Examiner was affirmed.

Claims 8 and 9 have been separately analyzed for compliance with the written description requirement. Instant claims 8 and 9 are of different scope than claims 2 and 3 of the Reexam. However, the rationale given in the Decision by the Board and the Judgment by the

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CAFC is relevant to the lack of written description of instant claims 8 and 9 and the Japanese priority document 02-019614.

Claim 2 in U.S. Pat. 5,216,135 claimed a much narrower genus than that disclosed in the Japanese priority document. Claim 2 is slightly broader in scope than instant claims 8 and 9. Claim 3 listed specific specie, which specific specie were not disclosed in the Japanese priority document. The Board decided that claims 2 and 3 lacked adequate written descriptive support from the Japanese priority document. The Board stated, "there is no more guidance in the Japanese application to select a slightly smaller subgenus than there is to select any other subgenus ." (page 10, second full paragraph of the Decision). Again, a decision by the CAFC on claims 2 and 3 was not rendered since Applicants chose not to appeal the Board's decision of claims 2 and 3 to the CAFC. In applying the rationale given by the Board and the CAFC to instant claims 8 and 9, there is no guidance in the disclosure in column 2, lines 16-48 to select the subject matter as claimed in instant claims 8 and 9.

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(4) The Declaration by Albert Tockman dated May 30, 2002 (see previous Office Action – Paper No. 44, page 4) and the second Tockman declaration dated December 12, 2002 have been considered. Both declarations offer Declarant's opinion that the subject matter of claims 8 and 9 is under subject areas of U.S. Pat. 5,216,135 and/or the Japanese priority document by pointing out expressions and terms in these documents that are inclusive of terms in the instant claims. Declarant then concludes that the inventors were in possession of the compounds of claims 8 and 9. However, Declarant has not shown persuasively where description is found, in the instant specification, for the subject matter of claims 8 and 9. All Declarant has done is to point out terms here and there and then conclude that Applicants are in possession of the claimed subject matter. Declarant has not shown where there is written description for the claimed subject matter. It is noted that Declarant indicates that claim 8 is drawn to compounds wherein R¹ is cyclohexyl and R² is cyclohexyl (item 8 of the Declaration filed December 20, 2002).

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Applicants do not have description for the subject matter of claims 8 and 9 in the instant specification. Therefore, the issue as to description in the Japanese priority document has no barring on the 35 U.S.C. 112, first paragraph, rejection herein.

The following is a quotation of the second paragraph of 35 U.S.C.

112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, there is a valence problem in the formula {e.g., $C=N$ }.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371⁹ of this title before the invention thereof by the applicant for patent.

Claims 8 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Pawlowski et al. {U.S. Pat. 5,338,641}.

Pawlowski et al. disclose the compounds in column 4, lines 32, 33 and 46.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pawlowski et al. {U.S. Pat. 5,338,641}.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicants claim diazodisulfones. Pawlowski et al. teach diazodisulfones {e.g. α,α -bis(sulfonyl)diazomethanes} which are either structurally the same as (see 102 rejection above) or structurally similar to the instant claimed compounds. See in the reference, for example, wherein R represents butyl (including positional isomers – e.g. *tert*-butyl) or cyclohexyl {column 3, lines 8-15, 40-49, 66-68 and column 4, lines 1-2 and especially the compounds in column 4, lines 32-34}.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between some of the compounds of the prior art and the compounds instantly claimed is that of generic description.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar compounds would possess similar activity (e.g. forms a strong acid on exposure to actinic radiation).

One skilled in the art would have been motivated to prepare compounds embraced by the reference genus to arrive at the instant claimed products with the expectation of obtaining additional beneficial compounds which would be useful in forming a strong acid on exposure to actinic radiation. Therefore, the instant claimed compounds would have been suggested to one skilled in the art.

Note: The Pawlowski et al. reference was not applied against newly added claim 10 under 35 U.S.C. §102(e) because of the different formula in claim 10.

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Allowable Subject Matter

Claim 7 is free of the art of record. Therefore, claim 7 is allowed.

The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Conclusion

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from

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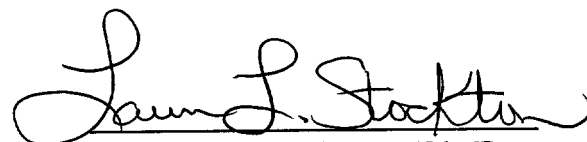
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the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura L. Stockton whose telephone number is (703) 308-1875. The examiner can normally be reached on Monday-Friday from 6:00 am to 2:30 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (703) 308-4537.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.



Laura L. Stockton, Ph.D.

Patent Examiner

Art Unit 1626, Group 1620

Technology Center 1600

February 27, 2003